REMARKS

Claims 1-12 are pending in the present application, with claims 1, 5 and 9 being independent.

In paragraph 7 of the Office Action ("Action"), the Examiner rejects claims 1, 2, 5, 6, 9, and 10 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. More specifically, the Examiner asserts that there is insufficient antecedent basis for the phrase "the original" and "the order" as recited in claims 1, 2, 5, 6, 9, and 10. Applicants respectfully traverse this rejection.

Applicants note that the use of the definite article "the" does not refer to antecedent basis but rather is necessary for idiomatic reasons. Furthermore, the failure to explicitly provide antecedent basis for a term does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. Inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation "the outer surface of said sphere" would not require an antecedent recitation that the sphere has an outer surface. (See MPEP §2173.05(e).) Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 2, 5, 6, 9, and 10 under 35 U.S.C. § 112, second paragraph.

In paragraph 10 of the Action, the Examiner rejects claims 1-12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2006/0010375 to Salesin et al. ("Salesin") in view of U.S. Patent Application Publication

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No. 2003/0005001 to Kataoka ("Kataoka"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Action must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, the rejection of claims 1-12 under 35 U.S.C. § 103(a) in view of the combination of Salesin and Kataoka is improper because the Examiner fails to establish a *prima facie* case of obviousness as discussed below.

Independent claim 1 defines a document revision support program for enabling a computer, with a view, to support revision of a document. The program includes, *inter alia*, means for inputting a document to be revised, means for converting the input document to data presented in a tree structure, and means for storing in said tree structured data a revision ID uniquely representing a version of the revision and an attribute representing a type of a revision made to a data element as list structure data.

Salesin discloses a system and method for improving document layout on arbitrary devices of different resolutions and size using manifold representations of content. Manifold representations of content according to Salesin are multiple versions of anything that might appear in a document, from text to images. The specific content is selected and formatted dynamically by a layout engine in order to best adapt to a

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given viewing situation. Salesin also discloses a user interface for authoring and editing the manifold content.

Kataoka discloses a technique for converting a compressed XML document to a format usable by an application. The method of Kataoka is capable of identifying an XML document prior to decompression and the compression type thereof. According to Kataoka, when an XML document is originally compress, an XML header is added to the compressed document that describes an encoding declaration.

However, neither Salesin nor Kataoka disclose or suggest a document revision support program as defined by claim 1. For example, neither Salesin nor Kataoka disclose or suggest means for converting an input document to be revised into data presented in a tree structure or means for storing in said tree structure data a revision ID uniquely representing a version of the revision and an attribute representing a type of the revision made to a data element as list structure data, as recited in claim 1.

In rejecting claim 1, the Examiner asserts that it would have been obvious to one skilled in the art to "modify the document revision support program taught by Salesin to include identifications for the version and type of modification as taught by Kataoka" because Salesin allegedly teaches a tree representing a document and storing versions of content and attributes and Kataoka allegedly teaches storing a version ID and the type of modification made to the content. This assertion is unfounded for the following reasons.

First, the mere fact that references can be combined is not sufficient in and of itself to establish the resultant combination obvious absent some evidence of the desirability to the proposed modification. (See MPEP §2143.01.) However, the Examiner appears to be asserting that one skilled in the art would have been motivated to modify/combine the cited references because the references are directed to similar technology (i.e., XML documents). The mere fact that Salesin teaches creating documents with manifold document and Kataoka discloses a method for determining if an XML document has been compressed by referring to header data does not provide any motivation or suggestion of the desirability of the modification suggested by the Examiner.

Second, the Examiner appears to have misinterpreted the teachings of Kataoka. The Examiner asserts that Kataoka discloses means for storing in the tree structured data a revision ID and an attribute representing a type of revision made to a data element. However, upon review of the passage cited by the Examiner (i.e., page 3, paragraph 53 of Kataoka), it is clear that Kataoka discloses storing an XML version and compression type in the XML header, not the tree structure as claimed. Furthermore, the XML version of Kataoka refers to the version of XML used, and not the revision of the inputted document as claimed. Accordingly, absent proper motivation to modify/combine Salesin and Kataoka, the rejection of claim 1 is improper.

Furthermore, even if, *arguendo*, one skilled in the art were motivated to combine Salesin and Kataoka as suggested by the Examiner, the combination would still fail to

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render claim 1 unpatentable because the combination fails to disclose each and every claimed element.

As discussed above, nowhere in Salesin nor Kataoka is there any disclosure or suggestion of means for storing in the tree structured data a revision ID uniquely representing a version of the revision and an attribute representing the type of revision made to a data element. In addition, neither Salesin nor Kataoka disclose or suggest means for converting an input document to be revised into data presented in a tree structure.

Although Salesin discloses a user interface for authoring documents with manifold content which is created and stored in a tree structure, nowhere in Salesin is there any disclosure or suggestion of means for converting an input document to be revised into data presented in a tree structure as claimed. Furthermore, although Kataoka discloses converting an XML document into a document object model (DOM) tree, the XML document is not a document to be revised as claimed.

Since Salesin and Kataoka both fail to disclose or suggest a document revision support program as claimed, the combination of these two references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Salesin and Kataoka, which Applicants do not concede, the combination would still fail to render claim 1 unpatentable because the combination fails to disclose each and every claimed element.

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Independent claims 5 and 9 define a computer readable medium and apparatus comprising the document support program as defined by claim 1. Therefore, claims 5 and 9 are patentable over the combination of Salesin and Kataoka for at least those reasons presented above with respect to claim 1.

Claims 2-4, 6-8, and 10-12 variously depend from independent claims 1, 5, and 9. Therefore, claims 2-4, 6-8, and 10-12 are patentable over the combination of Salesin and Kataoka for at least those reasons presented above with respect to claims 1, 5, and 9. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-12 under 35 U.S.C. § 103(a).

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle (Reg. No. 46,607) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.
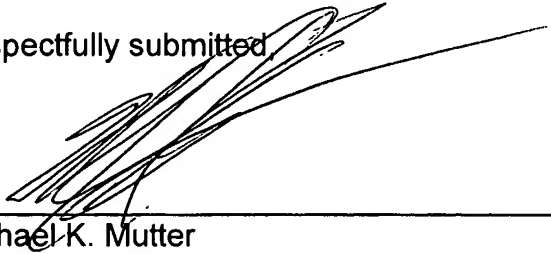
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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: May 16, 2006

Respectfully submitted,

By

Michael K. Mutter
Registration No.: 29,680
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment: Substitute Abstract of the Disclosure

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